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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 552,147	04 19 2000	Abraham Korol	102.3	3491

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EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 10 07 2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/552,147

Applicant(s)

KOROL ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 30 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1,2,4,6,8,9,11-17 and 31-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,2,4,6,8,9,11-17 and 31-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on with the Application is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 July, 2002, has been entered.
2. The cancellation of claims 18-22, the amendment of claims 1-2, 4, 6, 8, 11-17, 31-35, and 39-40, and the addition of new claims 41-46 requested in Paper No. 15, filed 30 July, 2002, have been entered. Claims 1-2, 4, 6, 8-9, 11-17 and 31-46 are pending.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The oath or declaration remains objected to for the reasons stated in the prior Office action because no new Oath or declaration was filed with the response of 30 July, 2002. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

### ***Response to Amendment***

5. The objection to claims 4, 33 and 40 because of informalities is WITHDRAWN in light of amendments to the claims.

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*Claim Rejections - 35 USC § 112*

6. Claims 1-2, 4, 6, 8-9, 11-17, 41 and 43 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a silicon carbide/pollen-mediated method of transformation of maize, does not reasonably provide enablement for use of that method in all sexually-reproducing plants. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The rejection is repeated for the reasons of record as set forth in the Office actions mailed 11 April, 2002, as applied to claims 1-2, 4, 6, 8-9, 11-18 and 20-22.

Applicant's arguments filed 30 July, 2002, have been fully considered but they are not persuasive. Applicant urges that the claims have been limited to maize, melon and tomato and that a new declaration with methods for transforming melon and tomato has been submitted (response pg 6).

This is not found persuasive because the declaration was not included with the response, and could not be addressed. However, the specification must teach the methods for transforming melon and tomato, and it does not. Additionally, claims 1-2, 4, 6, 8-9, 11-16, 41 and 43 are not limited to maize, melon and tomato. Thus, it remains unclear how taxonomically and structurally divergent plants could be transformed by such the method.

7. Claims 1-2, 4, 6, 8-9, 11-17 and 31-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections.

The rejection is repeated for the reasons of record as set forth in the Office actions mailed 11 April, 2002, as applied to claims 1-2, 4, 6, 8-9, 11-22 and 31-40.

Applicant's arguments filed 30 July, 2002, have been fully considered but they are not persuasive. Applicant urges that the claims have been amended to correct the defects (response pg 6). This is not found persuasive because numerous new defects were introduced.

Claims 1 and 31 lack antecedent basis for the limitation "said vortexed paste" in part (f).

Claims 11 and 37 lack antecedent basis for the limitation "the selection of transformants" in lines 1-2.

Claims 11 and 37 are indefinite in their recitation of "looking for the phenotypic expression of a specific cloned selectable marker gene with a phenotypic expression". First, it is not clear which phenotypic expression the gene has. Second, selection using antibiotic or herbicide resistance genes is done by growing the transformants on media comprising the antibiotic or herbicide, not by "looking" at them.

Claims 11 and 37 are missing an article before "antibiotic" and "herbicide" in lines 4-5.

Claim 32 lacks antecedent basis for the limitation "said silicon carbide fibers".

Claim 36 lacks antecedent basis for the limitation "said plasmid DNA". Claim 35, upon which claim 36 depends, refers to a "a solution of plasmid DNA".

Claim 36 lacks antecedent basis for the limitation "said selectable marker".

8. The claims are free of the prior art, given the failure of the prior art to teach pollen mediated transformation of dicots using silicon carbide fibers and given the inherent unpredictability of pollen mediated transformation of dicots or gymnosperms.

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*Claim Objections*

9. Claims 31-40, 42 and 44 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

*Conclusion*

10. No claim is allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst, Sonya Williams, at (703) 305-2272.

Anne R. Kubelik, Ph.D.  
September 30, 2002



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